

is glycol, located in a third fluid chamber of a decoupler sub-assembly. As the Examiner admits, Hodgson teaches a hydraulic mount assembly with glycol, *rather than a magneto-rheological fluid*, in the first and second fluid chambers 32, 44 and an electrorheological fluid, *rather than glycol*, located in the third fluid chamber 54. Nevertheless, the Examiner contends "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to have reversed the locations of the fluids in Hodgson's hydraulic mount . . . since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167."

Applicant respectfully submits that a reversal of parts that results in a change of function, as in the present case, may impart patentability. *Cf. In re Van Yzeren*, 185 F.2d 705 (C.C.P.A. 1950) ("In support of his holding that reversal of parts *without a change of function* cannot impart patentability to a claim, the examiner cited the case of *In re McNeil* . . . , which was cited with approval by this court in the case of *In re Sol Einstein*." (emphasis added)). Moreover, "[t]he mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims . . . is not by itself sufficient to support a finding of obviousness." *Ex parte Chicago Rawhide Manufacturing Co*, 223 U.S.P.Q. (BNA) 351, 353 (1984). "The prior art must provide a motivation or reason for the worker in the art, without the benefit of the [applicant's] specification, to make the necessary changes in the reference device." *Id.*

As detailed in the written description of the application as filed, the use of MR fluids in a hydraulic mount offers the benefit of active control. However, because MR fluids are approximately 2.4 times more dense than the hydraulic fluid used in standard hydraulic mounts, if the MR fluid in an MR mount is located in the decoupler subassembly, then the MR mount would need a decoupler that is roughly 2.4 times larger in area to achieve the same "choke off" frequency as a standard hydraulic mount. To overcome this disadvantage, Applicants' new hydraulic mount utilizes a lower density fluid, such as glycol, as the working fluid in the decoupler subassembly. Applicant's hydraulic mount still retains the benefit of active control, however, through use of MR fluid in the first and second chambers.

Applicant respectfully submits that the claimed invention is more than a mere reversal of parts taught by Hodgson. Applicant has claimed an improved MR mount that addresses the

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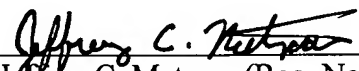
"choke off" frequency v. manufacturing tolerance tradeoff through the use of a low density working fluid like glycol in the decoupler subassembly. The art cited by the Examiner does not address this problem or propose the solution claimed by the Applicant. For at least these reasons, the art relied upon by the Examiner does not render claim 6 obvious.

New claim 18 depends from claim 6 and therefore is also patentable for at least the reasons provided with respect to claim 6.

Independent claim 7, like claim 6, recites a hydraulic mount assembly having a first fluid, *which is a magneto-rheological fluid*, located in first and second fluid chambers and a *different* hydraulic fluid located in a third fluid chamber of a decoupler sub-assembly. Therefore, claim 7 and claims 8-10, which depend from claim 7, are also patentable for at least the reasons stated above with respect to claim 6.

In light of the foregoing, Applicant respectfully requests that a timely Notice of Allowance be issued in this case. The Commissioner is hereby authorized to charge any additional fees which may be required by this paper, or to credit any overpayment to Deposit Account 20-0809. Prompt and favorable examination is requested.

Respectfully submitted,


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